

REMARKS

Claims 1-3 and 7-9 are currently pending in the application, of which claim 1 is an independent claim. Claims 4-6 and 10-22 are withdrawn.

In view of the following Remarks, Applicant respectfully requests reconsideration and timely withdrawal of the pending objections and rejections for the reasons discussed below.

Drawing Objection

In the Office Action, the drawings were objected to because in Figure 4, both reference numerals 32 and 31c point to the same feature. Figure 4 has been amended to correctly label the separator as reference numeral 32 and to label protective tape 35a wrapped around the outer surface at the edge of the negative electrode lead, as shown in the attached amended drawing sheet. Accordingly, Applicant respectfully requests withdrawal of the drawing objection.

Specification Objection

In the Office Action, the specification was objected to as failing to provide proper antecedent basis for claimed subject matter. Specifically, the examiner alleges that the specification "does not disclose that the negative electrode lead per se is made of copper or nickel." Applicant respectfully disagrees and asserts that paragraph beginning on page 10, line 11 ("Paragraph [0047]") as filed includes sufficient disclosure to satisfy 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o). Specifically, current interrupter 36a is described as "a region of the negative electrode lead 36." See Specification, Paragraph [0047]. However, to make explicit what was previous implicit, Applicant hereby amends Paragraph [0047]. Applicant respectfully submits that the above amendment does not add new matter to the application and is fully supported by the specification. Support for the amendment may be found at least in paragraph [0047] of the specification as filed and claims 8 and 9. Additionally, Applicant hereby amends

Paragraph [0047] to correct a minor typographical error. Accordingly, Applicant respectfully requests withdrawal of the specification objection.

Rejections Under 35 U.S.C. § 102

Claims 1-3 and 7-8 are rejected under 35 U.S.C. § 102(b) as being anticipated by Japanese Patent Publication No. 10-214614 issued to Inoue Takefumi ("Inoue"). Applicant respectfully traverses this rejection for at least the following reasons.

In order for a rejection under 35 U.S.C. § 102(b) to be proper, a single reference must disclose every claimed feature. To be patentable, a claim need only recite a single novel feature that is not disclosed in the cited reference. Thus, the failure of a cited reference to disclose one or more claimed features renders the 35 U.S.C. § 102(b) rejection improper.

Claim 1 recites, *inter alia*, an "electrode assembly for a lithium ion cell, comprising ... a negative electrode lead that is electrically coupled to the negative electrode plate and has a current interrupter which causes disconnection when an over-current flows" (emphasis added). Inoue does not teach these features. Specifically, Inoue fails to teach application of Inoue's invention to a lithium ion cell. Accordingly, Applicants respectfully assert the Inoue fails to teach every limitation of claim 1.

Since none of the other prior art of record discloses or suggests all the features of the claimed invention, Applicant respectfully submits that independent claim 1, and all the claims that depend therefrom are allowable. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 102(b) rejection of claims 1-3 and 7-8.

Rejections Under 35 U.S.C. § 103

Claims 9 is rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Inoue in view of U. S. Patent Application Publication No. 2005/0171383, filed by Arai, *et al.* ("Arai"). Applicant respectfully traverses this rejection for at least the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference or references, when combined, must disclose or suggest all of the claim limitations. The motivation to modify the prior art and the reasonable expectation of success must both be found in the prior art and not based upon a patent applicant's disclosure. *See in re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The examiner has failed to establish a *prima facie* case of obviousness because, *inter alia*, there is no suggestion or motivation to modify the references or to combine reference teachings.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

The examiner has failed to assert a motivation for combining the references. Specifically, the Office Action does not "present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Rather, the Office Action, on page 8, summarily concludes that it would have been obvious to combine Arai

and Inoue “to a person of ordinary skill in the art at the time the invention was made.” The sole justification proposed by the examiner was that “nickel is a suitable conducting metal material.” Hence, the Office Action appears to be relying solely upon the level of skill in the art to provide the suggestion to combine the references. Because the examiner does not provide a “convincing line of reasoning” to support this assertion, the examiner’s purported motivation cannot survive.

Furthermore, if the “proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP Chapter 2143.01.V (citing to *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984)). While the Office Action asserts that nickel may be substituted as an electrode lead, the more important question is whether there is a suggestion to substitute nickel for Inoue’s constricted portion 7a in the dimensions disclosed by Inoue, and whether nickel would be suitable to perform the function of Inoue’s constricted portion 7a in the disclosed dimensions. Applicant respectfully asserts that these suggestions are not found in either reference. Absent a suggestion of suitability as a constricted portion 7a, the examiner’s purported motivation cannot survive.

Since none of the other prior art of record, whether taken alone or in any combination, discloses or suggests all the features of the claimed invention, Applicant respectfully submits that claim 9 is allowable. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claim 9.

CONCLUSION

Applicant believes that a full and complete response has been made to the pending Office Action and respectfully submits that all of the stated objections and grounds for rejection have been overcome or rendered moot. Accordingly, Applicant respectfully submits that all pending claims are allowable and that the application is in condition for allowance.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the Applicant's undersigned representative at the number below to expedite prosecution.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

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Date: July 11, 2006

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